

REMARKS

Claims 1, 3-6, 8-10, 15, 20, 25 and 36-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by Haufe et al. (US 2004/0163370 A1). Claims 26-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by MacDonnell (US 3,830,042). Claims 2 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haufe et al. in view of applicant's earlier patent (6,468,324 B1). Claims 11-14 and 16-19, 21-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Haufe et al. in view of MacDonnell. Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haufe et al. or Lundberg (US 4,197,099) in view of MacDonnell.

Although the applicant sincerely believes that the claims as originally presented were patentably distinct over the prior art cited by the Examiner, claims 7-9, 20-31 and 36-41 have been cancelled without prejudice. Further, claims 1, 3 and 10 have been amended and now clearly distinguish the prior art of record. Claim 1 has been amended to specifically describe that at least some of the filters are a pocket filter and that at least some of the filters are a planar filter. Claim 1 has further been amended to describe that the pocket filters and the planar filters are interchangeable with each other so that the pocket and planar filters may be interchangeably positioned in the fluid flow area to vary the particulate holding capacity and/or pressure drop across the fluid flow area.

None of the prior art patents relied upon by the Examiner teaches the concept of providing a filter frame or a plurality of filter frames having the ability to have either

1 pocket filters or planar filters positioned thereon which are interchangeable with one
another so that the pocket and planar filters may be interchangeably positioned in the
fluid flow area to vary the particulate holding capacity and/or pressure drop across
the fluid flow area. Even though the prior art may be construed as teaching planar
5 filters and pocket filters, there is absolutely no suggestion whatsoever that the
references could be combined so as to provide a filter frame wherein pocket filters
and planar filters are interchangeably mounted to vary the particulate holding
capacity and/or pressure drop across the fluid flow area.

10 Applicant contends that the Examiner has failed to consider the claimed
invention and the prior art "as a whole." MPEP § 2141.02. In determining the
difference between the prior art and the claims, the question under 35 U.S.C. § 103 is
not whether the differences themselves would have been obvious, but whether the
claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip
15 Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A prior art reference must be
considered in its entirety, *i.e.*, as a whole, including portions that would lead away
from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d
1540, 220 USPQ 303 (Fed. Cir. 1983). Distilling an invention down to the "gist" or
20 "thrust" of an invention disregards the requirement of analyzing the subject matter "as
a whole." Id.

The mere fact that references can be combined or modified does not render
the resulting combination obvious unless the prior art also suggests the desirability of
the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
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1 statement that modifications of the prior art to meet the claimed invention would have
been 'well within the ordinary skill of the art at the time that the claimed invention was
made because the references relied upon teach that all aspects of the claimed
invention were individually known in the art' is not sufficient to establish a *prima facie*
5 case of obviousness without some objective reason to combine the teachings of the
references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Accordingly, it is believed that the claims remaining in this application are not
anticipated by any of the prior art references nor are they made obvious by any
10 combination of the prior art references.

As stated in the specification, applicant's invention enables planar filters and
pocket filters to be interchangeably mounted in a filter frame so that the pocket filters
may be positioned in the fluid flow area having the most particulate matter passing
therethrough. As also stated in the specification, in certain fluid flow areas the
15 amount of particulate in a certain area is greater and applicant's invention enables
the pocket filters to be interchangeably positioned in the areas having the most
particulate matter contained therein. Accordingly, it is believed that the claims in this
application are clearly patentable over the references of record.

20 No fees or extensions of time are believed to be due in connection with this
Amendment; however, please consider this a request for any extension inadvertently
omitted and charge any additional fees to Deposit Account No. 502093.



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CERTIFICATE OF MAILING

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I hereby certify that the original of this AMENDMENT for SCOTT B. BEIER, Serial No. 10/779,887, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313, on this 5th day of October, 2006.

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